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REMARKS

This Amendment is a full and timely response to the Office Action dated May 25, 2006.

New claims 27-31 have been added. Upon entry of the present amendment, claims 1-31 will be pending in this application. No new matter is added, and support for the amendments may be found throughout the specification and in the original claims.

In the May 25, 2006 Office Action, the Examiner rejected all claims 1-26. The Applicants respectfully traverse the Examiner's rejections. For the reasons set forth below, the Applicants submit that the rejections should be withdrawn and that the claims are in condition for allowance.

I. Claim Rejections – 35 U.S.C. § 101

The Office Action rejected claims 1-26 under 35 U.S.C. § 101 as being allegedly directed to non-statutory subject-matter. The Examiner states that the “computer system must set forth a practical application of that § 101 judicial exception to produce a real world result” and that the “invention is ineligible because it has not been limited to a substantial practical application.” Further the Examiner states that the “determination of a knowledge meaning item has no purpose in the real world” and that the final result of the claimed invention is not useful, tangible and concrete. Thus, the Examiner appears to be taking the position that the claims fall within a judicial exception (i.e., directed to an abstract idea) of statutory subject matter under 35 U.S.C. § 101.

The Applicants respectfully disagree that the claims fall into this judicial exception and that the claimed invention fails to produce a useful, concrete, and tangible

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result. *See Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility*, Official Gazette Notices, 22 November 2005, <http://www.uspto.gov/web/offices/com/sol/og/2005/week47/patgupa.htm> (hereinafter *Interim Guidelines*).

Claims 1-26 do produce a useful, concrete, and tangible result and, therefore, do meet the patentability requirement set out by § 101. The Federal Circuit has held that for a claimed invention to satisfy the requirements of 35 U.S.C. § 101, it must produce a “useful, concrete, and tangible result.” *State St. Bank & Tr. Co. v. Signature Fin. Group, Inc.*, 149 F.3d 1368, 1373-74 (Fed. Cir. 1998). In its *Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility*, the USPTO states that the Examiner should weigh the aforementioned factors to determine whether 35 U.S.C. § 101 is met. *See Interim Guidelines*. Because the Applicants’ claimed invention meets each of the three factors, as explained below, claims 1-26 are patentable under 35 U.S.C. § 101.

A. Useful

First, the Applicants’ claimed invention is useful. For this criterion to be met, the Patent Office requires a claimed invention’s utility to be “specific, substantial, and credible.” *See* M.P.E.P. § 2107(II)(A)(3); *Interim Guidelines*. The M.P.E.P. describes a “specific and substantial utility” as excluding “throw-away,” “insubstantial,” and “nonspecific” utilities. M.P.E.P. § 2107(II)(B)(1)(i). The Applicants’ claimed invention cannot be categorized as any of these three types of exclusions. Rather, it has the specific utility of determining the meaning of a knowledge item, such as a keyword. The claimed invention is useful, for example, in the context of associating an advertisement with a

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keyword that is in turn associated with content, such as a webpage. Therefore, the Applicants' claimed invention is useful, because it has a specific and substantial utility.

B. Concrete

Second, the Applicants' claimed invention is concrete. For this factor to be met "the process must have a result that can be substantially repeatable or the process must substantially produce the same result again." *Interim Guidelines*. The Applicants' claimed invention meets this criterion, because a meaning for a knowledge item is determined. When these methods are embodied and followed, the process of determining a meaning for a knowledge item is repeatable. Therefore, the Applicants' claimed invention is concrete, because it produces a result that is substantially repeatable.

C. Tangible

Third, the Applicants' claimed invention is tangible. This requirement "does not necessarily mean that a claim must either be tied to a particular machine or apparatus or must operate to change articles or materials to a different state or thing." *Interim Guidelines*. Rather, the claim must set out a "practical application" that produces a "real-world result." *Id.* The Applicants' claimed invention sets out a practical application in claims 1 and 14 (and, thus, to their respective dependent claims) by determining a meaning for a knowledge item based at least in part on the determined related meaning for related information associated with the knowledge item. The meaning can be used to associate an advertisement with the knowledge item and its associated content. Thus, because the Applicants' claimed invention has a practical application and produces real-world results, the claimed invention is tangible.

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Therefore, because each of the three criteria for patentability under § 101 are met, the Office Action rejection to these claims is believed to be traversed, and claims 1-26 are in condition for allowance.

II. Claim Rejections – 35 U.S.C. § 102

In the Office Action, claims 1-9, 11, 12, 14-22, 24, 25 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,848,396 (“Gerace”). In order to anticipate a claim under 35 U.S.C. § 102(e), “the reference must teach each and every element of the claim.” M.P.E.P. § 2131. Gerace does not teach or suggest all of the elements of any of the Applicants’ claims. Thus, the Applicants respectfully traverse these rejections.

Gerace relates to determining a user profile associated with a user and customizing webpage content based on the user’s profile. For example, Gerace discloses creating a user profile based on the pattern of the user’s viewing actions or habits. *See, e.g.*, 4:12-23. Gerace discloses displaying advertisements to the user based on the associated user profile. *See, e.g.*, 2:30-34, 4:30-36. Moreover, the display of the advertisements can be customized based on the user’s profile. *See, e.g.*, 5:20-25. Performance reports for the displayed advertisements may be created and provided to the advertisers. *See, e.g.*, 5:35-38.

Claims 1 and 14 of the present invention require “receiving related information associated with a knowledge item,” such as a keyword. The Examiner stated that this element was found at 9:40-51 in Gerace and that “related information” in the claims was equivalent to “page display” in Gerace. This referenced section of Gerace (9:40-51)

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relates to a "Messages" category of a Home Page that includes information relating to categories, such as personals advertisements, classified advertisements and real estate advertisements where a user can select a category and view the results. Even assuming that the displayed advertisements are displayed based on the user profile, this section of Gerace does not disclose or suggest receiving related information associated with a knowledge item as claimed by the present invention.

Claims 1 and 14 of the present invention also require "determining at least one related meaning based on the related information." The Examiner stated that this element was found at 11:13-23 of Gerace and "related meaning" in the claims was equivalent to "previously accessed" information of Gerace. This referenced section of Gerace (11:13-23) relates to a "City Page" that provides a Directory of names, addresses, telephone/facsimile numbers, and e-mail addresses. The numbers are displayed, according to Gerace, if the user has accessed them before. This section of Gerace does not disclose or suggest determining a related meaning based on related information as claimed by the present invention.

Claims 1 and 14 of the present invention further require "determining a knowledge item meaning for the knowledge item based at least in part on the related meaning." The Examiner stated that this element was found at 6:46-57 and that "knowledge item" of the claims is equivalent to "information that is generated when a user logs on and information is recorded pertaining to user activities of Gerace." This referenced section of Gerace (6:46-57) relates to information that is recorded by the program when a user logs on, such as the date and time, the referring link, the user's

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identification number, and the Web browser software employed on the user's computer.

This section of Gerace does not disclose or suggest determining a knowledge item meaning for the knowledge item based at least in part on the related meaning.

Since Gerace does not include all of the elements of claims 1 and 14, the Applicants respectfully request that the Examiner withdraw the rejection of claims 1 and 14.

Claims 2-9, 11, and 12 depend from claim 1 and claims 15-22, 24, and 25 and depend from claim 14 respectively and are patentable over Gerace for at least the same reasons as stated above for claims 1 and 14. Therefore, the Applicants respectfully request that the Examiner withdraw the rejection of claims 2-9, 11, 12, 15-22, 24, and 25.

III. Claim Rejections – 35 U.S.C. § 103

In the Office Action, claims 10, 13, 23 and 26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gerace in view of U.S. Patent No. 5,878,223 ("Becker"). Claims 10 and 13 depend from claim 1 and claims 23 and 26 depend from claim 14. For the reasons stated above, Gerace does not include all elements of claims 1 and 14 and thus, neither Gerace or Becker disclose or suggest all elements of claims 10, 13, 23, or 26. Therefore, the Applicants respectfully request that the Examiner withdraw the rejection of claims 10, 13, 23, and 26.

IV. New Claims 27-31

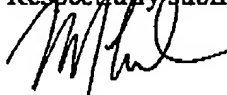
New claims 27-31 have been added. Applicants believe that new claims 27-31 are in condition for allowance.

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CONCLUSION

The foregoing is submitted as a full and complete response to the Office Action of May 25, 2006. Applicants respectfully request that a timely Notice of Allowance be issued in this case. If the Examiner believes that there are any issues that can be resolved by a telephone conference, or that there are any informalities that can be corrected by an amendment, please call 404 815 6061.

Respectfully submitted,



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